

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-31, all of which have been rejected. By this Amendment, claims 1, 11, and 21 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. Support for the above claim amendments may be found in, for example, FIG. 1A and ¶¶ 0040-0041 of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,212,730 ("Boston"), in view of U.S. Patent Publication No. 2002/0161713 ("Oh"). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

### **REJECTION UNDER 35 U.S.C. § 103**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere

conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

**I. The Proposed Combination of Boston and Oh Does Not Render Claims 1-31 Unpatentable**

The Applicant now turns to the rejection of claims 1-31 as being unpatentable over Boston in view of Oh. The Applicant notes that the proposed combination of Boston and Oh forms the basis for all of the pending rejections.

**A. Independent Claims 1, 11, and 21**

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Boston and Oh does not disclose or suggest at least the limitation of "automatically displaying, without user interaction, a notification of said received advertisement on said television, after said receiving of the advertisement," as recited by the Applicant in independent claim 1.

The Office Action states:

In reference to claims 1 and 21, Boston teaches a method (see Figure 8 described in Col. 8 Lines 52-53) of and processor (see processor 3000 of Figure 30 described in Col. 25 Lines 10-15) for providing an advertisement in a communication channel, the method and processor operation comprising receiving the advertisement for display on a television within a home (step 965 of Figure 9 described in Col. 10 Lines 2-4); **display a notification of the advertisement on said television, after said receiving of the advertisement (highlighted selection 1420 of Figure 14, as described in Col. 13 Lines 37-39; with further reference to Col. 13 Lines 26-35);**

See the Office Action at page 7 (emphasis added). The Office Action relies on the highlighted selection 1420 illustrated in FIG. 14. The Applicant points out that FIG. 14 of Boston illustrates a sample on-screen television guide where the starting guide position is determined by sponsorship. **Even though the highlighted selection 1420 illustrates a program that is sponsored by a program sponsor, the Applicant points out that the selection 1420 is a part of the on-screen guide 1400. Furthermore, the on-screen guide 1400 is a pop-up television guide, which appears only when it is requested by the user, i.e., when the user presses a key (or keys) on the DVR's remote control. See Boston at col. 13, lines 17-24.**

Therefore, **since user input is required for displaying the guide, Boston does not disclose that a notification of an advertisement is automatically displayed, without user interaction, after receiving of the advertisement,** as recited in Applicant's claim 1.

The Examiner also states the following in the "Response to Arguments" section of the Office Action:

It is the Examiners position that "automatically displaying" does not preclude user interaction. The "notification" in Boston is produced in response to the user's activation of the program guide, but the user's activation of the program guide does not directly result in the production of a notification.

See the Office Action at page 3. **In response to Examiner's argument cited above, the Applicant points out that claim 1 now recites "automatically displaying, without user interaction ...," which, in fact, precludes user interaction. In addition, as conceded by the Examiner in the above citation, the "notification" in Boston is produced in response to the user's activation of the program guide. In other words, there can be no notification without the user activating the program guide. Put another way, Boston discloses displaying of a notification, which is possible only in the presence of, and results from, user interaction.**

Furthermore in reference to Figure 9 of Boston, the Applicant points out that the DVR service provider selects commercials and sends the DVR service client a customized edit list that includes commercial identifiers, so that **the commercials are played or recorded at a certain time**, when the user is viewing or recording a

**particular channel.** See Boston, col. 9, lines 27-34. Furthermore, the commercials are played or recorded only when the user uses the client DVR, without providing any notification of received advertisements. See Boston, col. 10, lines 5-10. In this regard, the DVR client does not display any notification of received advertisements. This is further illustrated in Boston's Figure 10. For example, the custom edit schedule that identifies the commercials is retrieved at step 1010, only after a program is selected for playback or recording (at step 1005). Oh does not overcome the above stated deficiencies of Boston.

Therefore, the Applicant maintains that the combination of Boston and Oh does not disclose or suggest at least the limitation of "automatically displaying, without user interaction, a notification of said received advertisement on said television, after said receiving of the advertisement," as recited by the Applicant in independent claim 1.

Furthermore with regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Boston and Oh does not disclose or suggest at least the limitation of "scheduling based on input from a user provided after said displaying of said notification of said received advertisement, said received advertisement for viewing on said television," as recited by the Applicant in independent claim 1.

The Examiner, in page 7 of the Office Action, concedes that "Boston ... does not teach scheduling based on input from a user provided after said display of said

notification” and then relies for support on ¶¶ 0029-0030 of Oh. More specifically, the Examiner states the following:

In a similar field of invention, Oh teaches a method (Fig. 3) and processor (Fig. 2a and 2b) for allowing a user to schedule a advertisement to be played at a desired time designated by the user after a data stream of multimedia content is received and stored on a client device (as described in Paragraphs [0029-0030]).

See the Office Action at page 8. The Applicant points out that the relevant claim limitation here is “notification of said received advertisement.” Referring to ¶¶ 0027-0030 of Oh, Oh discloses that after a user selects multimedia content, the user may also select advertisement content as additional incentive (such as receiving the multimedia content at a reduced cost or for free). The system 100 then retrieves the multimedia content and the advertisement content and transfers them to the user. In other words, **the selection of advertisement content is performed prior to transferring of such content to the user.** This is further illustrated in Oh’s FIG. 3 and corresponding description in ¶¶ 0040-0052 (notification and decision to watch ad content is made in steps 313-317, and then the multimedia and ad content is delivered to the user for watching without any subsequent notifications of received ad content).

In reference to FIG. 2a of Oh, Oh discloses providing a list of ad content to the user. However, such list of available ad content is provided by the hardware 218 (which is part of system 100) only as part of the ad content selection process **prior to** communicating the multimedia and the ad content to the user. See Oh at ¶¶ 0032-0038. In this regard, FIGS. 2a-2b provide additional support that the selection of ad

content is still performed prior to transferring of such content to the user, as already explained above.

Paragraph 0030 of Oh simply states that instead of playing the multimedia content after it is received, the user may schedule the multimedia content to be played at a desired time. Consequently, ¶¶ 0029-0030 of Oh **do not disclose that the user is notified of any received advertisements. In other words, Oh does not disclose any “displaying of said notification of said received advertisement.” In fact, Oh also does not disclose any user input after displaying of such notification, and that scheduling of the received advertisements is based on such user input.**

Therefore, the Applicant maintains that the combination of Boston and Oh does not disclose or suggest at least the limitation of “scheduling based on input from a user provided after said displaying of said notification of said received advertisement, said received advertisement for viewing on said television,” as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not unpatentable over Boston in view of Oh and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2-10, 12-20, and 22-31**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Boston in view of Oh has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10, 12-20, and 22-31 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

Furthermore with regard to the rejection of claims 8, 18, and 28, the Applicant submits that the combination of Boston and Oh does not disclose or suggest at least the limitation of “granting permission to schedule said at least one advertisement for display within said identified gap,” as recited by the Applicant in claims 8, 18, and 28.

The Office Action concedes that Boston does not disclose this limitation, and then looks for support to ¶ 0030 of Oh. See the Office Action at pages 6 and 9-10. As already explained above, ¶ 0030 of Oh simply discloses that instead of playing the multimedia content after it is received, the user may schedule the multimedia content to be played at a desired time. Oh does not disclose of any “identified gap.” Furthermore, Oh at ¶ 0030 does not disclose that the user grants any permission to **schedule** the advertisement for display **within an identified gap**. In fact, **Oh is even silent as to any scheduling of advertisements with regard to identified gaps**. Therefore, the combination of Boston and Oh does not disclose or suggest at least the limitation of “granting permission to schedule said at least one advertisement for display within said



identified gap,” as recited by the Applicant in claim 8, 18, and 28. Therefore, claims 8, 18, and 28 are allowable over the references cited in the Office Action.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-10, 12-20, and 22-31.

In general, the Office Action makes various statements regarding claims 1-31 and the cited references that are now moot in light of the above. Thus, the Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: 10-OCT-2008

/Ognyan I. Beremski/

Ognyan Beremski, Esq.  
Registration No. 51,458  
Attorney for Applicant

MCANDREWS, HELD & MALLOY, LTD.  
500 WEST MADISON STREET, 34TH FLOOR  
CHICAGO, ILLINOIS 60661  
(312) 775-8176

/OIB